

REMARKS

Claims 1-25 are currently pending in the application. Applicant respectfully requests that the amendments to independent claims 1, 8, 15, and 22-25 indicated above be entered. No new matter has been introduced as a result of the claim amendments.

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0147704 to Borchers ("Borchers") in view of U.S. Patent No. 5,089,985 to Chang ("Chang") and U.S. Patent No. 6,006,218 to Breese *et al.* ("Breese").

Rejection Under 35 U.S.C. § 103(a):

As indicated above, claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borchers in view of Chang and Breese. As indicated in Applicant's "Response Pursuant to 37 C.F.R. § 1.111", filed on 6 October 2004 in response to the Office Action dated 6 July 2004, Applicant reserves the right to antedate Borchers in a future Response or on Appeal.

Each of the independent claims has been amended to require the carrying out of an electronic commerce transaction. None of the cited references disclose, teach, or suggest any aspect of carrying out an electronic commerce transaction. Accordingly, neither Borchers, Chang, nor Breese, whether taken singly or in combination, can render the present invention, as set forth in claims 1-25, obvious.

Moreover, each of the rejected claims recites product data and one or more seller databases. The Office acknowledges that "Borchers does not teach that the data is product data or that the database is a seller database."¹ The Office further indicates that "these limitations are not functionally involved in the elements of the recited system,

¹ Detailed Action, p. 2, ll. 16-17.

method, or program.”² Taking into account the amendments presented herein, the product data and the one or more seller databases are certainly involved in the carrying out of an electronic commerce transaction, as they are they provide the basis for products involved in the electronic commerce transaction.

Furthermore, regarding the patentable weight of the preamble, the Office indicates that “the body of the claim does not depend on the preamble for completeness and is able to stand alone because there is no commerce activity (*i.e.*, transaction) taking place in the body of the claim.”³ Taking into account the amendments presented herein, the claimed invention includes the limitation of carrying out an electronic commerce transaction. Accordingly, it would not have been obvious for one of ordinary skill in the art, at the time of the present invention, to use any aspect provided in Borchers (or Chang or Breese) in an electronic commerce environment.

All of Applicant’s arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the various references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these addition distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Office’s rejections.

For at least these reasons, it is respectfully requested that the amendments presented herein be entered into the record and that the rejection of claims 1-25 under 35 U.S.C. § 103(a), as being unpatentable over Borchers in view of Chang and Breese, be reconsidered and withdrawn.

² Detailed Action, p. 2, ll 17-18.

³ Detailed Action, p. 3, ll. 14-16.

The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION


The Applicant respectfully requests that the amendments provided herein be entered in the present Application. Applicant submits that all of the Examiner's rejections are hereby overcome. For at least the reasons set forth herein, the Applicant submits that claims 1-25 are in condition for allowance, and respectfully requests that claims 1-25 be allowed.

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. 500777.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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Date


James E. Walton, Reg. No. 47,245
Michael Alford, Reg. No. 48,707
Daren C. Davis, Reg. No. 38,425
Brian E. Harris, Reg. No. 48,383

Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)

jim@waltonpllc.com (e-mail)

CUSTOMER NO. 38441

ATTORNEYS AND AGENTS FOR APPLICANT